

REMARKS

This amendment is being filed in response to the Office Action having a mailing date of June 3, 2003. Claims 1-49 are canceled herein without prejudice. New claims 50-95 are added. No new matter has been added. With this amendment, claims 50-95 are pending in the application.

In the Office Action, claims 1-49 were rejected under 35 U.S.C. § 102(e) as being anticipated by Beck (U.S. Patent No. 6,332,154). Certain claims were also rejected under 35 U.S.C. § 112, first and second paragraphs.

The applicants thank the Examiner for taking the time to speak with the undersigned attorney on numerous occasions regarding claims 1-49 and the subject matter of the present application. During these telephone conversations, the Examiner indicated that she believed that there is nothing patentably distinguishable between the subject matter recited in the applicants' claims and the system and techniques disclosed by Beck. For example, during the last telephone conversation, the Examiner indicated that she believed that the structure claimed by the applicants is identical to Beck, and suggested that a possible way to distinguish over Beck may be to recite certain features of the applicants' user interface. No agreement was reached with the Examiner during these telephone conversations as to the allowability of any claims or specific amendments that can be made that would be sure to result in allowance.

While the Examiner has indicated that adding amendments directed toward the user interface may distinguish over Beck, the applicants believe that there are more fundamental differences between what is being claimed and what is disclosed by Beck. The applicants do not feel that it is appropriate at this time to dramatically reduce the scope of the independent claims by reciting specific user interface elements therein, and thereby surrender significant claim scope to which they are entitled.

Accordingly, new claims 50-95 are being presented in this amendment, and former claims 1-49 are hereby canceled without prejudice. New claims 50-95 recite subject matter that is fully supported by the original specification, and that clearly and convincingly distinguishes over Beck. As a starting point of discussion, the applicants will first explain the features, field of use, and other relevant implementation of embodiments of the present

invention, and then will discuss the specific and different use of the Beck technology, so as to clearly illustrate and emphasize key differences and the non-analogous art situation present before us.

Use of Embodiments of the Applicants' Invention in Connection With a Legal Proceeding.

One example of a legal proceeding that pertains to an embodiment is "discovery" that occurs during litigation of a case set for trial. Other examples of legal proceedings to which embodiments of the applicants' invention may be applied are mergers and acquisitions, due diligence efforts, or other document-intensive legal proceeding (*see, e.g.*, page 29, lines 22-26 through page 30, lines 1-8 of the present application). For the purpose of explanation, discovery will be used as a non-limiting example of a "legal proceeding" herein.

The discussion of the embodiments herein, and the discussion of the differences between these embodiments and subject matter described in Beck, do not define the scope or interpretation of any of the claims. Instead, such discussed differences are intended to merely help the Examiner appreciate important claim distinctions discussed thereafter.

The manner in which a lawsuit involving discovery evolves, such as described in the present application on pages 1-4 and on page 11 (lines 15-26) and elsewhere, can be summarized by the following example:

A. Employees within a company (both collectively or individually referred to hereinafter as "party X"), for example, can conduct personal and business-related activities using their desktop computers and/or their company's computer system. During the course of these activities, such employees may exchange emails with other employees or exchange emails with individuals outside of the company. These employees may also perform other generation of electronic documents, such as saving information into an electronic calendar or electronic schedule, creating a spreadsheet, generating a word processing file, creating graphical and textual information, or other generation of electronic files. These various electronic files may be saved locally on the hard drive of the employee's desktop computer and/or saved in some network storage

location or file system of their company's computer system. At least some of these locally saved or network-saved files may be stored in a directory structure.

B. While generating and storing all of these electronic files, the data present therein can be potentially used as evidence if a lawsuit ever occurs in the future. For example, two employees within the company may exchange internal email correspondence that discuss stealing technology of another company (referred to hereinafter as "party Y") used without permission of that company, for example.

C. Some time later, party Y files a lawsuit against party X, alleging that party X stole its trade secrets or otherwise misappropriated its technology. The filing of the lawsuit typically begins the legal proceeding.

D. As part of the legal proceeding, lawyers for party Y request that party X produce copies of electronic files that have been generated by the employees of party X prior to commencement of the legal proceeding (*i.e.*, the electronic files that have been stored locally, on network storage, or in some other storage location of the information system of party X). This request for electronic files is part of the "discovery" process, wherein each party in a lawsuit attempts to build its case by collecting information from the other party that can be used as evidence. The various stored electronic files that employees of party X have generated are potentially a rich source of evidence. In a typical discovery proceeding, the lawyers for party Y typically send "requests for production" to party X, so that party X may gather all of its electronic files and send them back in response to the requests for production.

E. In the prior art as described in the background section of the present application, the produced electronic files are typically printed in hard copy and then sent directly to the requesting attorneys. This is cumbersome since potentially thousands of hard copy pages have to be reviewed by the requesting attorneys, and because threading and other context information is not present in the hard copies (*i.e.*, lost during the conversion to hard copy). Therefore, an embodiment of the applicants' invention allows such electronic files to be processed without requiring the electronic files to be first printed in hard copy format. Another entity (such as Applied Discovery, which is the

assignee of the present application, or any other entity that provides similar services) provides a service that assists the attorneys in processing these electronic files. Applied Discovery itself is not directly involved in the lawsuit as a party of the lawsuit, but is instead providing a computer system service that assists the attorneys of party Y, for example, in building their case. The computer system provided by Applied Discovery to process these electronic files does not belong to any of the parties in the legal proceeding (*e.g.*, party X or party Y). Additionally, the information system in which the electronic files of party X were originally stored, does not belong to Applied Discovery but rather belongs to party X.

F. Applied Discovery's computer system first receives the electronic files that have been produced by party X in response to production requests tendered by Y's attorneys. These are the electronic files (or copies thereof) that have been generated and stored in the information system of party X over the course of perhaps years of its employees' tenure in the company. There are various mechanisms for delivery of these electronic files to Applied Discovery's computer system. Saved emails, spreadsheets, electronic calendars, word processing files, etc., may be transferred onto compact disks (CD) or other portable media, and then delivered to Applied Discovery. *See, e.g.*, Figure 1 and page 11, lines 15-26 of the present application. Alternatively or additionally, the electronic files may be delivered directly from the information systems to Applied Discovery's computer system via some direct download technique, without necessarily having to be transferred into a portable storage medium in the interim.

G. Applied Discovery's computer system receives these electronic files, which are now subject to the legal proceeding and which have been produced by at least one party (*e.g.*, party X) involved in the legal proceeding. As examples, the received electronic files can be random electronic files stored on CD, or they may be arranged in a directory structure, such as what may be found in a local hard disk or in network storage, or other data structure.

H. It is noted at this point that the stored electronic files received by Applied Discovery's computer system do not involve any current ongoing communication, such

as emails being communicated by party X employees to Applied Discovery's computer system. Rather, these are electronic files (such as "old emails") that have been previously stored in the information system of party X. For example, emails spanning several years have been stored in party X's information system, and are now the subject of and have now been delivered to Applied Discovery's computer system during the legal proceeding. There is no ongoing communication via these emails between the original senders (employees) of party X and any member of Applied Discovery.

I. As described with reference to Figures 1-3 of the present application, the computer system of Applied Discovery uses a plurality of recursive engines to extract the received electronic files from the data structure that has been received from the information system of party X, such as recursively extracting the electronic files from a directory structure saved on a CD. The extracted electronic files are then stored in a searchable format. Metadata associated with the received electronic files are also obtained, stored, and indexed. Furthermore, the extracted electronic files are also converted to a readable format, such as a read-only .pdf file. At least some of this electronic file information may be stored in a database system in one embodiment. *See, e.g.,* page 16, lines 5-11; page 17, lines 5-12; page 13, lines 15-23; page 18, lines 16-25; page 19, lines 6-10; and elsewhere in the application.

J. At least some of the extracted electronic files can include emails, which themselves may or may not include attachments. The metadata associated with these emails are obtained, such as information indicative of the sender, recipient, date, threading information, and other data. The metadata associated with any attachments are also obtained, stored, and indexed.

K. In one embodiment, a plurality of different applications can be used to read and translate the received electronic files, including email attachments. For example, if a particular email was generated using Lotus Notes™ version 1.5 with an attachment generated using WordPerfect™ version 2.0, then the computer system of Applied Discovery would use that same version of Lotus Notes™ and WordPerfect™ to open and read these electronic files.

L. Once the various electronic files have been stored and indexed, the electronic files can now be searched, reviewed, and processed by legal professionals (*e.g.*, party Y's attorneys) who are provided with access to Applied Discovery's computer system. As described with reference to Figures 4-6 of the present application, one or more user interfaces can be provided by Applied Discovery to these attorneys. These user interfaces allow the attorney to generate requests for electronic files having one or more specific characteristics. For example, an attorney may perform a search for all emails exchanged between the president and vice president of party X between 1994 and 1995, which discuss the technology of company B. Via this request in an example embodiment, a query is applied to the database system of Applied Discovery, specifying characteristics such as sender, recipient, date, subject, related threads, properties information, key words, and other data associated with the corresponding electronic files.

M. The indexed metadata and other stored information is processed to determine a set of electronic files having the characteristics specified in the request, and then the matching electronic files are returned to the user via a hit list or other indication. The attorney can then look at a copy of each electronic file, and add legally relevant annotations, such as "reviewed," "privileged," "hot," "responsive," and others. The attorney can follow email threads from one email to another, as well as saving annotated search results. *See, e.g.*, Figure 4 and the accompanying description in the present application.

The example described above is fully set forth throughout the original application as filed. The use of embodiments of the applicants' invention in connection with legal proceedings as claimed is nowhere to be found in Beck, and involves features and implementations that are not in Beck.

The Beck System.

Nowhere does Beck disclose, teach, or suggest use of its system in connection with a legal proceeding. Rather, Beck involves a customer relationship management (CRM)

system that has nothing to do with legal proceedings and which cannot be implemented to support a legal proceeding. Thus, the Beck system describes non-analogous art.

The operation of the Beck system is summarized as follows:

A. The Beck system is installed in a customer service department of a company that provides goods and services to consumers. The Beck system is integrated with the communication system of the company, such as with its incoming/outgoing telephone and facsimile links. *See, e.g.*, column 7, line 33 through column 9, line 5 of Beck.

B. Customers of the company having the Beck system installed therein send email or voice communications to the Beck system. *See, e.g.*, column 9, lines 49-58; and Figures 1-2 and 8 and accompanying description of Beck. These communications relate to product or service inquiries, such as requesting additional information about a certain product offered by the business, a complaint about a purchased product, or other customer relationship issue.

C. These communications from the customer are sent directly to the Beck system. *See, e.g.*, column 9, lines 49-58; and Figures 1-2 and 8 and accompanying description of Beck. The communications are live and ongoing. The customers are not delivering a plurality of old stored electronic files (such as on CD, for example) from their information systems to the Beck system. In fact, typically with these live communications, the consumers are either speaking live on the telephone, or sending in a live email or fax to the Beck system.

D. The customers of Beck are in no way, shape or form involved in a legal proceeding, wherein they are delivering electronic files that are subject to the legal proceeding to the Beck system, so as to allow the Beck system to analyze the data in these electronic files for legal purposes. Rather, these are customers who are inquiring and interacting with the Beck system in order to have a particular customer need serviced. Servicing a customer need is not the same as participation in a legal proceeding.

E. The received communication from the customers are then processed by the Beck system, so as to provide a customer service representative that can most adequately service the need of the inquiring customer. Nowhere does Beck use recursive extraction to extract electronic files, which are subject to a legal proceeding, from a received storage medium or other data structure. Also, since Beck involves interaction with customers, the customers have no need to, and therefore do not send, electronic calendars, electronic schedules, spreadsheets, electronic files arranged in a directory structure, or other such data to the system of Beck. Why, for instance, would a customer requesting service on a purchased child's toy send a copy of his desktop computer's C-drive directory to Beck's customer service representative? Such a customer would not send such information. Rather, the system of Beck receives only ongoing telephone, voicemail, and facsimile communications, since these are the only formats that are suitable for conveying and responding to customer service inquiries.

F. The Beck system does not provide any sort of user interface where legally related annotation tools can be provided to add annotations to electronic files that are subject to the legal proceeding.

In summary, therefore, the system of Beck cannot be and is not implemented in the context of being able to receive a plurality of electronic files that are subject to a legal proceeding. The system of Beck processes files that are directly communicated to the system of Beck, and does not and cannot process files that have been previously stored in an external information system and which have now been produced and delivered as part of the legal proceeding.

Discussion of the Claims.

New claims 50-95 recite at least some of the differences and features described above. These claims are fully supported by the specification, and overcome all of the rejections enumerated by the Examiner in the present Office Action.

New independent claim 50 recites a method in a computer system for analyzing data produced for legal purposes. As described above, Beck does not disclose, teach, or suggest

this feature. Beck relates to a CRM system that is directed toward servicing customer inquiries. The servicing of customer inquiries simply does not involve the analysis of data produced for legal purposes.

Independent claim 50 further recites "receiving, from an external information system, a plurality of electronic files that are subject to a legal proceeding, the electronic files produced by at least one party involved in the legal proceeding." This feature is nowhere taught, suggested, or motivated by Beck, because there is nothing in Beck that discloses receiving a plurality of electronic files that are subject to a legal proceeding. The electronic files of Beck relate to customer inquiries and in no way involve a legal proceeding. Moreover, the parties that provide the electronic files to the Beck system are not involved in a legal proceeding, but are instead basic customers wishing to have a need serviced.

The remainder of claim 50 recites various elements of storing, indexing, receiving a request, and processing, which all relate to the recited electronic files that are subject to the legal proceeding and which have been produced by at least one party involved in the legal proceeding. Again, these elements distinguish over Beck because the electronic files received and processed by Beck are not subject to a legal proceeding and are not produced by a party involved in the legal proceeding. Therefore, new claim 50 is allowable over Beck.

The various dependent claims that depend directly or indirectly on independent claim 50 also recite subject matter that is distinctive over Beck. Some of these dependent claims will be discussed next. For example, dependent claim 55 recites that the legal proceeding is at least one of a discovery proceeding, a mergers and acquisitions proceeding, and a due diligence effort. These types of legal proceedings are in no way described in or suggested by Beck, and indeed, Beck does not have the capacity to process electronic files involving any type of legal proceeding.

Dependent claim 56 recites that the external information system belongs to the at least one party of the legal proceeding and wherein some of the electronic files have been previously sent from the at least one party to another party prior to commencement of the legal proceeding. Dependent claim 56 also recites that the computer system that receives the stored electronic files does not belong to any party of the legal proceeding. The recitations of this claim

distinguish over Beck because the Beck system does not involve a legal proceeding but instead involves customer service. Furthermore, the electronic files received by the Beck system are not received from an external information system that belongs to a party involved in a legal proceeding, wherein that party has previously sent at least some of the electronic files to another party prior to commencement of the proceeding. Rather in Beck, the electronic files, such as email communications, are ongoing communications being sent from a customer directly to the system of Beck, and such electronic files have not been previously sent from at least one party to another party prior to delivery to the Beck system.

Dependent claim 58 recites certain examples of the plurality of electronic files, such as electronic calendars, electronic schedules, electronic files arranged in a directory structure, and other data. These types of electronic files cannot be and are not received by the Beck system. As described above, the Beck system only receives telephone, voicemail, and facsimile that pertain to customer inquiries, and has no need to receive and cannot process electronic files received in a directory structure, an electronic calendar, and the other types of electronic files recited in claim 58.

Dependent claims 60 and 61 recite recursively extracting the plurality of electronic files from a data structure provided from the external information system. Nowhere does Beck disclose a recursion technique to extract electronic files from a data structure. Rather, with reference to Figure 3 of Beck, which the Examiner has cited, the system of Beck processes each incoming event in turn to determine the type of media involved with the event, and then extracts relevant data and routes the event for further processing. This is not the same as applying a recursive extraction technique to a data structure having a plurality of electronic files in order to extract the electronic files therefrom.

Dependent claim 62 recites that the electronic files are recursively extracted from a storage medium delivered from the external information system in response to a production request during the legal proceeding. As described above, since Beck does not involve a legal proceeding, there can be no "response to a production request" in Beck, and therefore this claim distinguishes over Beck. Moreover, this claim recites that the electronic files are recursively extracted from a storage medium delivered from the information system. An example of such a

storage medium is a CD or magnetic tape having copies of electronic files of a party that is involved in the legal proceeding and which has downloaded its information system data onto the storage medium. Because the Beck system involves direct interaction with customers via telephone line, there can be no delivery of any type of storage medium having a plurality stored electronic files that are subject to a legal proceeding. That is, the Beck system receives data directly but does not receive any sort of storage medium on which that data is stored.

Dependent claim 63 recites that the plurality of electronic files are extracted using application programs that can read and translate the electronic files. This is a feature not disclosed in Beck. Dependent claims 64 and 65 recite the application of annotations to the electronic files, wherein dependent claim 65 further recites that these annotations can include various legally related selections provided via a user interface. Again, these are features that are not disclosed, taught, or suggested by Beck, since the Beck system relates to servicing customer inquiries rather than analysis of data for legal purposes.

New independent claim 69 is directed towards a method in a computer system for analyzing data produced for legal purposes. Claim 69 recites receiving, from an external information system, a plurality of electronic files that are subject to a legal proceeding, the electronic files produced by at least one party involved in the legal proceeding and stored in a data structure in the external information system prior to being received at the computer system. As described above, these are features that are not found, taught, or suggested by Beck. Beck involves a CRM system that directly processes ongoing communications with customers. Beck does not receive stored electronic files that are subject to a legal proceeding from an external information system.

The remainder of claim 69 recites elements of recursively extracting electronic files, obtaining and indexing meta data, converting the recursively extracted electronic files, and indexing contents of the recursively extracted electronic files. Beck does not use any type of recursive technique to extract electronic files stored in a data structure received from an external information system, and does not disclose, teach, or suggest the other elements recited in claim 69.

Independent claim 75 is a claim directed towards an article of manufacture comprising a machine-readable medium having instructions stored thereon (software) to cause a processor to analyze data produced for legal purposes. The software of Beck does not analyze data produced for legal purposes, and therefore new claim 75 is allowable over Beck. Moreover, new claim 75 also recites loading, from an external information system, a plurality of electronic files subject to a legal proceeding. The electronic files are further recited as being produced by at least one party involved in the legal proceeding and stored in a data structure in the external information system prior to being loaded at the computer system. As discussed extensively herein, Beck does not involve a legal proceeding and does not receive electronic files that are subject to a legal proceeding. Furthermore, the Beck system does not receive electronic files that are stored in a data structure prior to being loaded in the Beck system. Rather, Beck directly receives ongoing electronic communications that are not subject to a legal proceeding.

New independent claim 79 is directed towards a computer system for analyzing data produced for legal purposes. The claim recites a means for receiving, from an external information system, a plurality of electronic files that are subject to a legal proceeding, the electronic files being produced by at least one party involved in the legal proceeding. These are not features found in Beck, and therefore new claim 79 is allowable over Beck.

New independent claim 85 is directed towards a computer system to analyze data produced for legal purposes. This claim further recites at least one recursive engine to receive, from an external information system, a plurality of electronic files that are subject to a legal proceeding. These are features not found in Beck.

New claim 85 further recites that the electronic files are produced by at least one party involved in the legal proceeding and which are stored in a storage medium. The recursive engine extracts the plurality of electronic files from the storage medium. This feature is in contrast to what is disclosed in Beck. Beck directly processes ongoing non-legal-proceeding-related communications that are sent directly to its system. Accordingly, claim 85 is allowable over Beck.

The various dependent claims that depend on these new independent claims recite subject matter that is distinctive over Beck. For the sake of brevity, these distinctive features

will not be discussed and contrasted to Beck in further detail herein. Such distinctive features can be readily ascertained by reading the recitations contained in these dependent claims and by comparing them to the teachings of Beck.

Other Comments and Conclusion.

In making the rejections in the present Office Action, the Examiner stated on page 3, paragraph 6, that the term "storage system" presented in the prior amendment was not disclosed in the original specification and is therefore considered new matter. By canceling the claims relevant to this rejection, this issue has been rendered moot by the applicants. However, the applicants do note for the record that the "database system" disclosed in the original application is indeed a "storage system."

Furthermore on page 4, lines 1-3 of the present Office Action, the Examiner stated that the term "a storage system" is recited in every independent amended claim. The applicants also respectfully note for the record that the "storage system" or "database system" was not recited in all of the previously amended independent claims, and is instead recited in only some of them. Therefore, any claim that does not explicitly recite "storage system" or "database system" should not to be narrowly construed to include these terms.

On page 5, paragraph 13 of the Office Action, the Examiner rejected certain claims because of their use of the phrase "can be." This rejection is rendered moot and/or overcome by canceling these claims, and by reciting more definitive language in the new claims.

On page 5, paragraph 14 and on page 9, paragraph 29, the Examiner issued a rejection under 35 U.S.C. § 112, second paragraph because she believed that the added terminology regarding "the electronic files being previously communicated independently of and externally to a network portion having the server" is unclear and is nevertheless found in Beck. By cancellation of these claims, this rejection is rendered moot. However, the applicants do note for the record that they believe that the application as originally filed and as a person skilled in the art can readily appreciate based on the applicants' disclosure, such a recitation is clear, is fully supported, and does in fact distinguish over Beck.

The appropriate fee for the extension of time is included along with this amendment. No new fee claims are being submitted because the originally filed claim fees still cover the total number of claims that remain pending after this amendment.

Overall, none of the references singly or in any motivated combination disclose, teach, or suggest what is recited in the independent claims. Thus, given the above amendments and accompanying remarks, the independent claims are now in condition for allowance. The dependent claims that depend directly or indirectly on these independent claims are likewise allowable based on at least the same reasons and based on the recitations contained in each dependent claim.

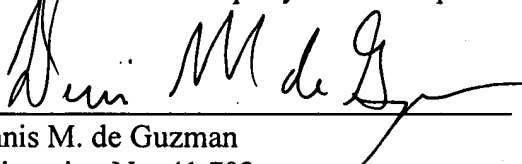
If the undersigned attorney has overlooked a teaching in any of the cited references that is relevant to the allowability of the claims, the Examiner is requested to specifically point out where such teaching may be found. Further, if there are any informalities or questions that can be addressed via telephone, the Examiner is encouraged to contact the undersigned attorney at (206) 622-4900.

The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

All of the claims remaining in the application are now clearly allowable. Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,

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